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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,551	11/06/2003	Young-Hoon Kim	1349.1316	8321
21171	7590	08/07/2007	EXAMINER	
STAAS & HALSEY LLP			WILLS, LAWRENCE E	
SUITE 700			ART UNIT	
1201 NEW YORK AVENUE, N.W.			PAPER NUMBER	
WASHINGTON, DC 20005			2609	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/701,551

Applicant(s)

KIM, YOUNG-HOON

Examiner

Lawrence E. Wills

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) —
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :6/29/2004, 11/28/2005, 7/7/2006, 4/5/2007 .

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Saito (U.S. Patent 6,128,101)** in view of **Borenstein (WO 92/22033 A1)**.

**With regard to claim 1, 12, 13, 17, 18, 21, and 22**, Saito teaches an e-mail facsimile machine (Figure 2) connected to an e-mail server 3 to send and to receive a scanned document using an e-mail, comprising: a mail sending unit 17 to convert the scanned document image to an e-mail format and to send the scanned document using the e-mail to the e-mail server; a mail receiving unit 17 to receive an e-mail from the e-mail server. (Column 2, line 57 – column 3, line 9) Saito also teaches the transfer, deletion, and printing of mail when requested. (Column 2, lines 50-52 and Figure 2, printing unit 24)

Saito does not teach a post processing operation unit.

Borenstein teaches a post-processing operation adding unit 50 to add a post-processing operation to the e-mail to be sent; and a post-processing operation implementing unit 70 to check whether there is a post-processing operation designated

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in the received e-mail and to implement the post-processing operation as designated (Page 13, lines 15-23).

At the time when the invention was made, it would have been obvious to one of ordinary skill in the art to include the post processing adding/implementing unit from the Borenstein reference in the e-mail facsimile machine taught in the Saito reference.

The suggestion/motivation for doing so would have been to make the transfer and deletion of messages less complex and more user friendly.

Therefore, it would have been obvious to combine Borenstein with Saito to obtain the invention as specified in claims 1, 12, 13, 17, 18, 21, and 22.

**With regard to claim 2,** Borenstein teaches the post-processing operation adding unit 50 uses a non-standard header to add the post-processing operation to the e-mail to be sent, (Page 13, lines 15-23). The active message header is equivalent to the non-standard header.

**With regard to claim 3,** Borenstein teaches the post-processing operation implementing unit 70 checks whether there is a post-processing operation designated in the non-standard header of the received e-mail, (Page 13, lines 15-23).

**With regard to claim 4,** Saito teaches a post-processing operation is to delete the received e-mail located at the e-mail server, (Column 2, lines 50-52).

**With regard to claim 5**, Saito teaches a post-processing operation is to forward the received e-mail to another e-mail address, (Column 2, lines 50-52).

**With regard to claim 6 and 19**, Borenstein teaches a method of post-processing an e-mail facsimile, comprising: selecting a post-processing operation of an e-mail to be sent; recording a command in response to the selection of the post-processing operation on a non-standard header of the e-mail; incorporating the command, the scanned document, and the non-standard header; setting a post-processing flag and storing the post-processing information via a post processing operation implementing unit; and implementing the post-processing operation by checking the post-processing flag, (Figure 2 and Page 13, lines 15-23).

Borenstein does not teach scanning a document and sending the e-mail to an e-mail server.

Saito teaches the scanning of a document, (Column 3, lines 13-14), and sending of e-mail to an e-mail server 3, (Column 2, lines 45-46 and Figure 1)

At the time when the invention was made, it would have been obvious to one of ordinary skill in the art to include the post processing adding/implementing unit from the Borenstein reference in the e-mail facsimile machine taught in the Saito reference.

The suggestion/motivation for doing so would have been to make the processing of messages less complex and more user friendly.

Therefore, it would have been obvious to combine Borenstein with Saito to obtain the invention as specified in claims 6 and 19.

**With regard to claim 7 and 9,** Borenstein teaches the post-processing operation information inputted is recorded on a non-standard header of the e-mail to be sent, (Page 13, lines 15-23). The active message header is equivalent to the non-standard header.

**With regard to claim 8 and 20,** Saito teaches An e-mail facsimile post-processing method using an e-mail facsimile machine connected to an e-mail server, comprising: receiving an e-mail from the e-mail server; checking whether there is a post-processing operation designated in the received e-mail via an e-mail facsimile machine connected to the e-mail server; memorizing the post-processing operation; printing out contents of the e-mail; and implementing the memorized post-processing operation, (Column 2, lines 50-52).

**With regard to claims 10 and 11,** Saito teaches a sender is allowed to perform the post-processing operation to the e-mail after the e-mail has been received and stored by the e-mail server of a receiver, (Column 2, lines 50-52).

**With regard to claim 14 and 16,** Saito teaches the mail sending unit prepares the e-mail using the image data created (Column 3, lines 4-17), and e-mail addresses

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input by the sender, (Figure 1, Sender Side Terminal 1). The Sender Side Terminal is equivalent to a computer which would obviously have a display and input.

**With regard to claim 15**, the post-processing operation adding portion 50 adds the post-processing operation by recording a command to implement the specific post-processing operation on a non-standard header of an e-mail header, (Page 13, lines 15-23). The active message header is equivalent to the non-standard header.

### ***Claim Rejections - 35 USC § 112***

3. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 16 recites the limitation "input portion attached to the display unit" in claim 12. There is insufficient antecedent basis for this limitation in the claim.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Eguchi (U.S. Patent 7,023,586), Saito et al. (U.S. Patent



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6,587,219), Tanimoto (Publication 2002/0186419), Tanimoto (Publication 2002/0131089), and Shiro (EP 0748107).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence E. Wills whose telephone number is 571-270-3145. The examiner can normally be reached on Monday-Friday 7:30 AM - 4:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Eisen can be reached on 571-272-7687. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEW  
July 26, 2007

  
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